



Attorney's Docket No.: 04873-031003

# 9 Resp.  
2/12/02  
amw

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Jerome Swartz  
Serial No. : 09/706,112  
Filed : November 3, 2000  
Title : METHOD AND APPARATUS FOR READING AND WRITING INDICIA  
SUCH AS BAR CODES USING A SCANNED LASER BEAM

Art Unit : 2876  
Examiner : J. Fureman

Commissioner for Patents  
Washington, D.C. 20231

RECEIVED  
FEB - 5 2002  
TC 2500 MAIL ROOM

RESPONSE

This is responsive to the office action mailed June 18, 2001.

The examiner has rejected the only independent claim (20) as being unpatentable over Takahashi in view of Christopher. The examiner is urged to reconsider and withdraw the rejection.

Takahashi merely teaches a scanner for scanning pages fed past a roller. The scanner is incapable of being hand-held, and has no provision for writing an image. In short, it is completely lacking in relevance to the claimed invention.

Christopher merely teaches a hand-held printer that uses a thermographic printhead to print indicia on labels. Although the device also incorporates a bar code scanner, scanning is not used for printing the indicia.

There is no motivation in either Takahashi or Christopher for making the examiner's proposed combination. And furthermore, it is not at all clear that anyone skilled in the art would arrive at the invention were some combination of Takahashi and Christopher attempted. After all, neither reference teaches using scanning for the purpose of printing indicia, and thus that central element of the claimed invention would not be arrived at by combining the two

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

November 19, 2001

Date of Deposit

Signature

Lisa G. Gray

Typed or Printed Name of Person Signing Certificate

Applicant : Jerome Swartz  
Serial No. : 09/706,112  
Filed : November 3, 2000  
Page : 2

Attorney's Docket No.: 04873-031003

references. Moreover, Christopher's use of scanning in its bar code scanner, but thermal printhead in its printer, teaches away from using scanning for printing.

The remaining claims are all properly dependent on claim 20, and are allowable therewith.

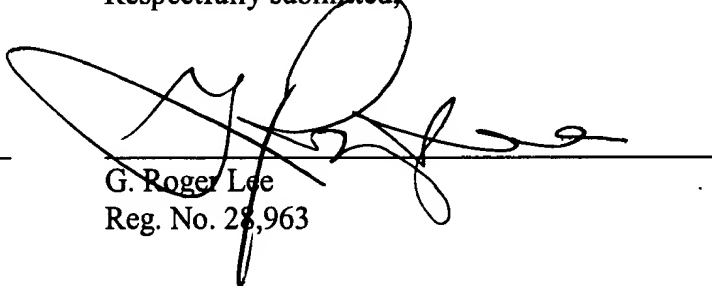
The examiner has also made an obviousness type double patenting rejection over U.S. Patent No. 5,825,402 in view of Takahashi and Christopher, and over U.S. Application No. 09/176,064 in view of the same references. A terminal disclaimer is enclosed herewith to overcome the double patenting rejection as to the '402 patent. A terminal disclaimer for the '064 application will be filed if it becomes necessary by grant of a patent.

Accordingly, all claims are in condition for allowance.

Applicant asks that all claims be allowed. Enclosed is a \$400 check for the Petition for Extension of Time fee. Please apply any other charges or credits to Deposit Account No. 06-1050.

Respectfully submitted,

Date: 11/19/01

  
G. Roger Lee  
Reg. No. 28,963

Fish & Richardson P.C.  
225 Franklin Street  
Boston, Massachusetts 02110-2804  
Telephone: (617) 542-5070  
Facsimile: (617) 542-8906